APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,109	03/16/2001	Kaoru Shimamura	1046.1248	8921

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EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/809,109	SHIMAMURA, KAORU
	Examiner	Art Unit	
	Yogesh C. Garg	3625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>21 August 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,5-9,11,12,16,18-20,23 and 24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1, 5-9, 11-12, 16,18-20, and 23-24</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/12/2006 has been entered.

Response to Amendment

2. Applicant's amendment received on 7/12/2006 is acknowledged and entered. The applicant has amended claims 1,5-7,11-12,16,20,23-24, and canceled claims 2,13 and 17. Currently claims 1, 5-9, 11-12, 16,18-20, and 23-24 are pending for examination.

Response to Arguments

3. Applicant's arguments (see pages 9-11 of Remarks) have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendments.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Claims 1, 5-9, 11, 20, and 23-24 are rejected under 35 U.S.C. 101 because the

claimed inventions are directed to non-statutory subject matter.

System claim 1 is directed to disembodied data structure which are per se not

statutory. C.f. In re Wamerdam. Claim 1 recites a system comprising several sections,

such as unit storage section, detecting storage section, etc. which all represent mere

program codes without being embedded into a computer readable medium to be able to

execute the program code. Functional descriptive material, in combination with a

computer readable medium is capable of producing a useful, concrete and tangible

result when used in a computer system is statutory. C.f. *In re Wamerdam* - data

structure stored in a computer memory, and *In re Lowery, 32* USPQ2d 1031 (Fed. Cir.

1994) - data structure in a computer readable medium.

A claim to a computer readable medium encoded with functional descriptive material

that can function with a computer to effect a practical application that results in a useful,

concrete an tangible result (i.e. running an assembly line or executing a stock

transaction) satisfies Section 101. Examples of Statutory Functional Descriptive Material

are:

(a) A claimed computer-readable medium encoded with a functional data

structure – this defines structural and functional relationships between the data structure

and the hardware/software components. See Wamerdam.

(b) A claimed computer-readable medium encoded with a computer program -

this defines structural and functional relationships between the computer program and

the computer itself which allows the program's functionality to be realized provided that

a useful, concrete and tangible result is realized. See U.S. Patent 5,710,578 to

Beauregard et al.

Since claims 5-6 are dependencies of claim 1 they inherit the same deficiency.

Further system claims 7-9, 11, 20, and 23-24 are also analyzed and rejected on the

basis of same rationale.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.1.   Claims 1, 5-6 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim 1 recites the limitations, "the data" in line 21of claim 1 and "the data

storage section" in line 23 of claim 1. There is insufficient antecedent basis for these

limitations in the claim. Since claims 5-6 are dependencies of claim 1 they inherit the

same deficiency. Claim 11 is rejected for the same deficiencies as that analyzed for

claim 1.

Claim 12 recites the limitations, " the unit storage section" in line 14 of claim 12,

"the data" in line 19 of claim 12 and "the data storage section" in line 21 of claim 12.

There is insufficient antecedent basis for these limitations in the claim.

6   Examiner cites particular columns and line numbers in the references as applied

to the claims below for the convenience of the applicant. Although the specified

citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply as well. It

is respectfully requested that, in preparing responses, the applicant fully consider the

references in entirety as potentially teaching all or part of the claimed invention, as well

as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

7   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.1.   Claims 1,5-6,11 and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Walker et al. (US Publication 2006/0212358 A1), hereinafter referred

to Walker in view of Ying, and further in view of Szabo.

Regarding claim 1, Walker discloses a system for selling goods through a

computer network (Figs 1-3 and Figs 5 through 12), where the goods are a variety of

elements which are different from each other and are sold one by one and the system

comprising:

a unit storage section (Price database "86", in fig.3) storing a plurality of units

for each good, each unit being a price per element corresponding to a range of

elements to which the goods being purchased is to be applied, an element being an

unit of the goods being purchased (see Figs 5A, 5B, 6C and 13. Different price units

are displayed for each good depending upon different range of elements, that is fourth

price unit of $2.75 corresponds to the fourth condition, that is number of elements

being purchased are equal to or more than 10, the third price unit of $ 2.90 is

applicable to number of elements being purchased are 6 or between 6 and 10 and so

on);

a detecting section detecting the number of elements to be purchased on the

basis of information of one or more goods to be purchased which is received from a

purchaser(see at least Fig.13 which indicates that the system detects the quantity of

goods for the transaction);

a purchase record storage section storing the number of elements purchased

by a purchaser in the past and an addition section reading the number of elements

purchased in the past from the purchase record storage section when the number of

elements is detected by the detecting section and adding the read number to the

detected number, a reading section reading at least one unit corresponding to the

elements to be purchased on the basis of the number of elements detected and a

result of addition by the addition section, a first calculating section calculating the

number of elements belonging to a range to which the read at least one unit is to be

applied and a second calculating section calculating the purchase price by using the

read at least one unit price and the number of elements calculated (see at least

paragraphs 0150-0153, 0168 and figs.3, 6C, 15, 16A and 20. Transaction database 90

and customer database 92 store records of the past transactions, such as shown in

Fig.15 customer database 92, as shown in fig.16 A indicates a range of elements, that

is Gold, Bronze, Silver, Retail corresponding to the total number of elements

purchased for an item. Note: The range of elements represented by Gold, Bronze,

Silver and Retail correspond to different range of elements as shown in Fig.6C. Fig.20

and paragraph 153 discloses adding records of past purchases and current

transaction for determining and providing progressive discounts for current purchases.

Referring to Fig. 6C, 16 A and 20 it is apparent, for example, if an user wants to buy 6

items currently and has already purchased 5 items in the past [based on past records

user is eligible for Bronze tier that is the unit price corresponding to second price of

$2.95] but on adding the current quantity of 6 items he would be eligible for both

Silver and Gold ranges, that is for 5 items, Silver tier is applicable and for 6th item Gold

tier would be applicable. Based upon the unit prices of corresponding tiers the

purchase prices for the current first 5 items and 6th item would be calculated).

Walker does not disclose a system wherein the "goods" denotes a variety of

font sets, wherein the font set comprises of elements, element being a character.

However, Ying, in the same field of endeavor, that is selling goods on line teaches

selling goods denoting a variety of font sets, wherein the font set comprises of

elements, element being a character (see at least col.2, line 13-col.3, line 40, col.10, line 14-col.16, line 61). In view of Ying, it would have been obvious to one of an ordinary skilled in the art to modify the system of Walker to incorporate the features of Ying of selling goods denoting a variety of font sets, wherein the font set comprises of elements, element being a character because it will enable the users to sell and purchase fonts online and allow the users to vary the size of his letters to pack text more densely, using a variety of fonts to visually distinguish different parts of the text, for aesthetic use, art decoration, etc., as explicitly suggested in Ying (see at least col.1, line 59-col.2, line 11 and col.2, line 59-col.3, line 5).

Walker does not disclose a data storage section storing a set of the data and a creating a supply file including data corresponding to information of the elements to be purchased by using the set of data stored in the data storage section and including data purchased by the purchaser in the past and a supplying section supplying the created supply file to the purchaser. However, in the same field of online selling and buying, Szabo discloses a data storage section, creating section creating a supply file including data corresponding to information of the elements to be purchased by using the set of data stored in the data storage section and including data purchased by the purchaser in the past and a supplying section supplying the created supply file to the purchaser (see at least col.6, lines 11-41 where in the purchaser's previous shopping lists are stored and made available to him for his current shopping resulting in a new shopping list including data from the previously purchased items and any changes due to his current requirements are sent from the server to the client.). In view of Szabo, it

would be obvious to one of an ordinary skilled din the art at the time of the applicant's

invention to have modified Walker to include the features of a data storage section,

creating section creating a supply file including data corresponding to information of

the elements to be purchased by using the set of data stored in the data storage

section and including data purchased by the purchaser in the past and a supplying

section supplying the created supply file to the purchaser because, as explicitly

argued in Szabo, it would provide great tool and convenience to the purchasers

purchasing repetitive items in constructing shopping lists using the previously

purchased shopping lists as in many instances the previously stored shopping list may

be nearly complete and eliminating the need for the purchaser to start from scratch.

Regarding claim 5, the limitation that the set of data is a font set data and that

a piece of the data is font data as an element of the font set data is already covered in

claim 1 analyzed above.

Regarding claim 6, Walker/Ying/Szabo combined discloses further

comprising a data storage section storing data set and the set of data represents

sentences divided every predetermined range, wherein the data represents the

range constructing sentences (see at least Ying col.2, line 21-col.3, line 6 and

col.30, line 30-col.31, line 4). In view of Ying, it would have been obvious to one of

an ordinary skilled in the art to modify the system of Walker to incorporate the

features of Ying of selling goods denoting a variety of font sets, wherein the font set

comprises of elements, element being a character, section storing data sets and

that the set of data represents sentences divided every predetermined range,

wherein the data represents the range constructing sentences because it will

enable the users to sell and purchase fonts online and allow the users to vary the

size of his letters to pack text more densely, using a variety of fonts to visually

distinguish different parts of the text, for aesthetic use, art decoration, etc., as

explicitly suggested in Ying (see at least col.1, line 59-col.2, line 11 and col.2, line

59-col.3, line 5).

Regarding claims 11-12, their limitations are closely parallel to the limitations of

claim 1 and therefore they are analyzed and rejected on the basis of same rationale.

7.2.   Claims 7-9, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Walker et al. (US Publication 2006/0212358 A1), hereinafter referred to Walker in

view of Ying.

Regarding claims 7-9, Walker combined with Ying discloses a system (see

Walker at least Figs 1-2) for a purchaser to purchase goods through a network, , the

system comprising a transmitting section transmitting information of one or more goods

to be purchased to a seller and the goods are different from each other, a receiving

section receiving a price of the one or more goods to be purchased and a display

controlling section displaying the received price on a display (see Walker at least Figs 1-

2 and paragraphs 0068-0071).

Walker does not disclose that the goods being purchased denote a variety of

font sets, wherein the font set comprises of elements, element being a character.

However, Ying, in the same field of endeavor, that is selling goods on line teaches

selling goods denoting a variety of font sets, wherein the font set comprises of

elements, element being a character (see at least col.2, line 13-col.3, line 40, col.10,

line 14-col.16, line 61). In view of Ying, it would have been obvious to one of an

ordinary skilled in the art to use the system of Walker incorporating the features of

Ying of selling goods denoting a variety of font sets, wherein the font set comprises of

elements, element being a character because it will enable the users to sell and

purchase fonts online and allow the users to vary the size of his letters to pack text

more densely, using a variety of fonts to visually distinguish different parts of the text,

for aesthetic use, art decoration, etc., as explicitly suggested in Ying (see at least

col.1, line 59-col.2, line 11 and col.2, line 59-col.3, line 5).

Note: Claims 7-9 are recited as system claims comprising a transmitting section,

a receiving section and a display controlling section which corresponds to the client's

terminal in the applicant's disclosure (see Figs 1-2 and pages 6-8). Claims Directed to

an Apparatus/system must be distinguished from the prior art in terms of structure

rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a " recitation with respect to the manner in which a claimed

apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the

claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the

structural limitations of claims 7-9 and 23, including a transmitting section, a receiving section and a display controlling section on a client's terminal are disclosed in Walker as described herein. The other intended use limitations, that is how the price is calculated/determined and what received information data should consists of do not distinguish the claimed apparatus from the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant claims 7-9 and 23 they do not recite structure configured to calculate/determine price or create supply files hence the prior art of Walker which discloses all the structural components, that is a transmitting section, a receiving section and a display controlling section it is capable of performing the intended use, and therefore it meets the limitations recited in claims 7-9 .

Regarding claim 23, its limitations are closely parallel to the limitations already covered in claims 7-9 and is therefore analyzed and rejected on the basis of the same rationale used for claims 7-9.

7.3.   Claims 16, 18-20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker/Ying/ Szabo.

Regarding claims 16, 18-20 and 24, their limitations are already covered while analyzing the limitations of claims 1, 5-9 and are therefore analyzed and rejected as being unpatentable over Walker/Ying/ Szabo using the same rationale.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

     (i) US Patent 6,142,371 to Oneda teaches storing past purchase records and

then discount rates for current purchases are defined based upon the past purchase

records (see at least Abstract and col.2, line 32-col.3, line 63).

     (ii) US Patent 6,687,679 to Van Luchene et al. teaches a method and apparatus

for determining progressive discounts based upon past purchase records (see
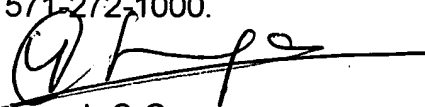
Abstract).

     (iii) US Publication 20030050895 1 to Dedrick et al. discloses allowing discounts

on current purchased products based upon the number of elements purchased in past

(see at least Abstract and paragraph 0021).

     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-

6756. The examiner can normally be reached on Increased Flex.

     If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
10/30/2006